

**REMARKS**

Applicant requests reconsideration of the application as amended.

**Status of the Claims**

Claims 1-11 and 15 to 18 are pending in the present application. Claims 12 to 14 have been withdrawn in response to a restriction requirement. Claim 18 has been amended.

**Rejection Under 35 U.S.C. § 112, second paragraph**

Claim 18 was rejected under 35 U.S.C. § 112, second paragraph, as indefinite in use of “said collapsible border assembly.” Claim 18 was amended for greater clarity.

**Rejections Under 35 U.S.C. § 103(a)**

Claims 1 to 11 and 15 to 18 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over the purported combination of U.S. Patent Publication 2003/0000021 A1 (O’Connell) with U.S. Patent Publication 2004/0055086 A1 (Owens, Jr.). According to the Examiner, O’Connell teaches a polyurethane foam border assembly and Owens discloses a “collapsible foam foundation for a bed mattress comprising hinges.” The Examiner contends that it would have been obvious to modify O’Connell to add the hinges shown in Owens to allow pivotable movement of the side and end rails of O’Connell’s border assembly. Applicant respectfully disagrees and traverses the rejections.

As a preliminary matter, Applicant notes that in order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner bears the burden of establishing three elements: “[f]irst there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference . . . must teach or suggest all the claim limitations.” (MPEP § 2142). In the present case, Applicant submits that the Examiner has not met this burden for at least the reason that no motivation has been shown for modifying the teachings of O’Connell in order to

obtain Applicant's claimed invention. Moreover, persons of ordinary skill in the art would not have been motivated to attempt to combine O'Connell and Owens, Jr. in the manner the Examiner has proposed where the Examiner has hindsight knowledge of Applicant's claimed invention.

O'Connell discloses a mattress border construction in which foam rails are supplied with double-sided adhesive tape. O'Connell specifically positions the tape on the end walls of each foam end rail (See FIGs. 1, 4 and 5). Optionally, the adhesive tape may also be applied to top and bottom surfaces of the end rails and side rails to permit bonding with other mattress components (See FIGs. 7-9). O'Connell does not teach or suggest that the rails may be pivotably attached to one another. Instead, O'Connell shows that his rails may be stacked one on top of the other within a shipping carton (see FIG. 3; see also para. [0025]). The double-sided tape is not positioned to form a hinge and does not provide pivotable attachment between side and end rails. O'Connell wants the entire strip of adhesive tape to "fixedly adhere" or "fixedly attach" to the side wall of an adjacent foam rail (e.g., Paras. [0007] and [0009]).

As set forth in claim 1, Applicant claims variously a border assembly, a mattress and a kit wherein the border assembly for the mattress is constructed from foam rails that are pivotably attached together. One possible pivotable attachment is by a hinge. Different from O'Connell, Applicant developed a collapsible border assembly that could be shipped in its collapsed state to save space and expense, and could be opened to form a border assembly of desired shape and size on site at the mattress fabricator. The workers would not need to identify which foam rails were end rails or side rails, and would not need to position the ends of the rails together to adhere the proper parts together to form the mattress. Instead, with the claimed invention, the four rails are already pivotably attached together. Upon removal from the shipping packaging, the collapsible assembly can be opened into position, ready for use in fabricating a mattress. Applicant's collapsible border assembly thus further simplifies mattress fabrication, and represents an improvement over O'Connell.

Owens, Jr. does not fill the gaps in the disclosure of O'Connell. Owens, Jr. has nothing to do with border systems for mattresses or simplifying mattress fabrication. Rather, Owens, Jr. concerns a foundation system onto which a bedding mattress may be

positioned. The foundation is used in place of a standard box spring. Owens, Jr.'s foundation system has a rigid member (30), a foam layer (32) and a fabric cover (34). Legs (16) can be attached to the bottom surface of the rigid member (30). The system can have a border (42, 44, 46), but such border is rigid and not made of foam. Two or more foundation systems may be connected together by hinges (14), but the hinge connection is between the rigid members. Skilled persons seeking to improve the construction of bedding mattresses and foam rail borders used in such mattresses would not be disposed to consider Owens, Jr.

The Examiner may not rely upon hindsight reconstruction. *In re Fritch*, 23 USPQ.2d 1780, 1784 (Fed. Cir. 1992) ("It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious."). The mere fact that the prior art may be modified in some manner as suggested by an Examiner does not make the modification obvious unless the prior art suggested the desirability of such modification. 23 USPQ.2d at 1783-84. Here, a person having ordinary skill in the art would not be motivated to modify the teachings of O'Connell to allow for pivotable movement between side rails of a border assembly. Owens, Jr.'s hinged connection of rigid members does not provide motivation to pivotably attach resilient foam border rails. The Examiner improperly picks out selected teaching from Owens, Jr. (hinges) where there is no motivation in O'Connell or in Owens, Jr. to do so.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness in view of O'Connell and Owens, Jr.

The Examiner further cites U.S. Patent 4,197,602 (Johanning) for disclosure of a border for a waterbed mattress where such border has mitered corners. Johanning does not fill the gaps in the disclosures of O'Connell and Owens, Jr. Applicant's claim 7 requires a specific side rail construction in which one side rail end is mitered and one end is square. Claim 7 further requires a specific end rail construction in which one end rail end is mitered and one end is square. The adjacent side and end rail thus fit together at the mitered ends to form one corner of the mattress border assembly. As shown in FIG. 5, this permits the two mitered ends to form a corner of the border, with the square end of each to form another corner of the border with the other side and end rails. The border

thus has mitered ends at opposite corners, and square ends at the other corners. None of O'Connell, Owens, Jr. or Jochenning contemplate side and end rails of a border construction with different configurations (mitered and square). With these configurations being pivotably attached as set out in claim 7, the border assembly is collapsible for shipment, but readily opened to form the border construction for a mattress. Accordingly, claim 7 and all claims depending from claim 7 patentably distinguish from the art cited by the Examiner, whether taken alone or purported to be combined.

### Conclusion

In view of the foregoing, the rejections should be withdrawn and all pending claims should be allowed.

If prosecution may be further advanced, Examiner is invited to telephone the undersigned to discuss this application.

No fee is believed due for this response. If there are any fees due in connection with the filing of this response, such as a fee for an extension of time, such extension is requested and the fee should be charged to Deposit Account No. 03-2775.

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Respectfully submitted,



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